



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/727,248

11/29/2000

Christopher A. Lee

ODS-20

4353

1473 7590 10/26/2007
ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

EXAMINER

HARPER, TRAMAR YONG

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

10/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

27

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/727,248
Filing Date: November 29, 2000
Appellant(s): LEE, CHRISTOPHER A.

MAILED
OCT 26 2007
GROUP 3700

Christopher A. Lee
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 13, 2007 appealing from the Office action mailed November 13, 2006.

Art Unit: 3714

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The brief identifies ODS Properties, Inc, the assignee of rights in the present application as the party of interest.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

Claims 1-46 are rejected.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

Art Unit: 3714

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Tulley et al.	US 6,688,976 B1	February 10, 2004
Stronach	WO 2000/67215 A1	November 9, 2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stronach (WO 00/67215) in view of Tulley et al (US 6,688,976).

Claims 1-46: Stronach discloses that upon actuation of the quick pick button the wagering terminal automatically selects racing candidates based on various algorithms (Pg. 10:21-29). Each time the quick pick button is actuated the wagering terminal selects a different set or arrangement of racing candidates based on different algorithms within the processor program. The player can continue to press the button until the candidates selected are unacceptable (Pg.

Art Unit: 3714

15:10-15). This is interpreted as a random means of automatically selecting candidates. Random number generators are well known in the art as a means of automatically selecting a random outcome or event. Such generators randomly select numbers based on some type of algorithm. Stronach discloses the use of a network and the Internet and the communication may be wired or wireless. Stronach discloses various types of racing information that can be displayed to the player and that the communications network may be wired or wireless systems using a telecommunications or cable network, which means phone or cable (Pg. 6-7). Stronach further discloses a betting card and an account manager in detail and viewing race events at more than one track and future race events (Pgs. 8-15). A detailed reading of Stronach by an artisan of ordinary skill would teach all of the claimed invention, except explicitly a random number generator means for automatically selecting candidates or racers located remotely from the wagering terminal or at a host location. Tulley et al. discloses a lottery system that comprises of a controller (host system) networked to remote terminals or player devices (Col. 11:20-30 & 52-60). If requested from the player via the player device, the controller implements a "quick pick" application that randomly generates lottery numbers for the player (Col. 5:1-9; Col. 16:57-67). If the initial randomly selected numbers are deemed unacceptable (the combination repeats elsewhere) the controller can regenerate a new selection set (Col. 7:55-65). Tulley discloses that such a system can be used for pari-mutuel horse racetrack betting where the player has to select in order the top three horses that will win a race (Col. 21:42-53). Tulley discloses that

Art Unit: 3714

additionally the player can request that his/her selections be associated with a limited number of occurrences e.g. the randomly generated combination only occurs a certain amount of times. It would have been obvious to one of ordinary skill at the time of the invention to modify the wagering system of Stronach with the random "quick pick" number generated application at the host system of Tulley et al. Such a modification would provide an alternative and/or equivalent random means of automatically selecting candidates for the player in the event that the player is indecisive about what selections to make.

(10) Response to Argument

Appellant argues that the two motivations cited by the examiner are insufficient to maintain the obviousness 35 U.S.C. 103(a) rejection.

A. Tulley Does Not Disclose that the "Quick Pick" feature May Be Used with Pari-mutuel Racetrack Wagering Argument.

Appellant argues that Examiner misinterprets the "Quick Pick" feature being applied to Pari-mutuel racing. However, Examiner respectfully disagrees for the following reasons:

Tulley et al. discloses a lottery system that comprises of a controller (host system) networked to remote terminals or player devices (Col. 11:20-30 & 52-60). If requested from the player via the player device, the controller implements a "quick pick" application that randomly generates lottery numbers for the player (Col. 5:1-9; Col. 16:57-67). If the initial randomly selected numbers are deemed unacceptable (the combination repeats elsewhere) the controller can regenerate

Art Unit: 3714

a new selection set (Col. 7:55-65). Tulley discloses that such a system can be used for pari-mutuel horse racetrack betting where the player has to select in order the top three horses that will win a race (Col. 21:42-53).

More specifically, Tulley discloses that, "Although many embodiments described above are directed to pari-mutuel lotteries, the present invention may also be used with respect to, for example, pari-mutuel racetrack betting. For example, some types of racetrack bets require that a player select, in order, the top three horses that will win a race. According to an embodiment of the present invention, a player may also request that his or her selections be associated with a limited number of occurrences (e.g., that his or her selections be unique). According to other embodiments, a player may be assured that his or her selections in a sporting wager (e.g., a college basketball playoff tree) will be associated with a limited number of occurrences. (Col. 21:40-53)"

When interpreting the above passage, the examiner concludes that the statement "the present invention may also be used with respect to, for example, pari-mutuel racetrack betting" clearly encompasses the "invention" previously disclosed in its "entirety" (**including the disclosed "quick pick" feature within the pari-mutuel lottery aspect of the prior art**) and not limited to a player requesting that their selections be "associated with a limited number of occurrences (e.g., that his or her selections be unique)." Furthermore the above passage states, "a player **may also** request that his or her selections be associated with a limited number of occurrences (e.g., that his or her selections be unique)." The terms "may also" makes the limited occurrences feature an

Art Unit: 3714

additional feature and not a limiting feature. In summary Examiner contends that the prior art of Tulley provides enough disclosure that one of ordinary skill in the art would apply the "Quick Pick" feature disclosed towards pari-mutuel racetrack betting.

B. One Skilled in the Art Would Have No Motivation to Combine Stronach and Tulley in the Way Proffered by the Office Action Argument.

Appellant respectfully disagrees with Examiner's motivation to combine the references, which states, "Such a modification would provide an alternative random means of automatically selecting candidates for the player in the event that the player is indecisive about what selections to make." Appellant states, "Stronach already includes a means for automatically selecting candidates." Appellant further states, "the deterministic algorithms already provided in Stronach's wagering terminals are perfectly suitable for selecting racing candidates as they are based on handicapping data of the candidates." Examiner agrees that that Stronach does disclose a automatic means of selecting racing candidates, wherein various algorithms corresponds or generates various sets of candidates. Each time the selection button is actuated a different algorithm is used to determine a new random set of candidates (Pg. 10:20-30). The Examiner interprets this process to require or imply some form of a random number generator means. For example, if there are 10 algorithms used to generate different sets of candidates than the system has to randomly designate which algorithm to use (1 to 10) each time the select button is actuated. Furthermore, each algorithm would have to randomly designate or

Art Unit: 3714

select different candidates from a set of candidates (for instance 1 to 10) or designate the order based on the type of wager (Stronach discloses wagers such as "Pick A Winner", "Pick Two Any Order", "Pick Two Exact Order", etc (Pg. 9:5-10)). The above implies that some type of random number generator means would have to be used, but does not explicitly disclose a "random number generation" means. However, it is clear that Stronach provides a type of random automatic application means of selecting racing candidates, but for purposes of prosecution Examiner had to find further evidence of a "random-number generation" application, which is well known in the art. Tulley discloses a lottery system that comprises of a controller (host system) networked to remote terminals or player devices (Col. 11:20-30 & 52-60). If requested from the player via the player device, the controller implements a "quick pick" application that randomly generates lottery numbers for the player (Col. 5:1-9; Col. 16:57-67). If the initial randomly selected numbers are deemed unacceptable (the combination repeats elsewhere) the controller can regenerate a new selection set (Col. 7:55-65). At least in the above regard Appellant does not argue the invention of Tully teaching a random number generation application.

Furthermore, Tulley discloses that such a system can be used for pari-mutuel horse racetrack betting where the player has to select in order the top three horses that will win a race (Col. 21:42-53). Based on at least this disclosure in regards to Tulley's system being implemented in horse race track betting, Examiner contends that Tulley teaches an equivalent or suitable means of automatically selecting race candidates. Furthermore, both references are the

Art Unit: 3714

same field of endeavor and are both drawn towards providing a player or user with an automatic means of generating quick picks or candidates for a race. Random number generators are well known in the art for providing random scenarios to players, who choose not to or prefer not to determine outcomes whether for a lottery, sporting event, or racing event. It would have been obvious to one of ordinary skill at the time of the invention to substitute and/or modify the random selection means of Stronach with the random number generation means of Tulley to provide predictable results. Therefore, Examiner respectfully contends that one skilled in the art would be motivated to substitute a random selection means for another random selection means and/or combine teachings of random selection means for purposes of providing predictable results such as randomly selecting racers/candidates for a player.

C. One skilled in the Art Would Not Find It Obvious To Combine Stronach and Tulley To Achieve Appellant's Claimed Invention Argument

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the **knowledge generally available to one of ordinary skill in the art**. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Art Unit: 3714

Appellant respectfully argues that there is no reason why one skilled in the art would incorporate Tulley's random "quick pick" process into Stronach's wagering terminals. Appellant states, "Stronach's automatic runner selection algorithms....use different weighting of handicapping data to automatically select racing candidates." Furthermore, that "Stronach's runner selection algorithms select runners based on known information that can be useful in to determining which runner is more likely to win." Appellant discloses in regards to Tulley that "Lottery games are random events. Each number has equal odds of being selected. Accordingly, one of ordinary skill in the art would not find it obvious to apply such a random selection process from that has equal odds to a race where each runner typically has different odds." Examiner respectfully disagrees with this interpretation of Tulley. Tulley et al. discloses a lottery system that comprises of a controller (host system) networked to remote terminals or player devices (Col. 11:20-30 & 52-60). If requested from the player via the player device, the controller implements a "quick pick" application that randomly generates lottery numbers for the player (Col. 5:1-9; Col. 16:57-67). If the initial randomly selected numbers are deemed unacceptable (the combination repeats elsewhere) the controller can regenerate a new selection set (Col. 7:55-65). Tulley discloses that such a system can be used for pari-mutuel horse racetrack betting where the player has to select in order the top three horses that will win a race. Tulley discloses that additionally the player can request that his/her selections be associated with a limited number of occurrences e.g. the randomly generated combination only occurs a certain amount of times (Col. 21:42-53).

When considering these factors applied to a pari-mutuel race game as disclosed by Tulley, the random number generator would have to encompass those sets of chosen candidates who have a limited number of occurrences. For example, if a set of candidates selected by a first player is associated with only 1 occurrence in the racing game. Then the odds of the random number generator generating a particular candidate or set of candidates is limited, when considering that generator and/or can only have one occurrence of the already chosen.

Therefore, the "quick pick" feature of Tulley uses weighted variables such as the one above for randomly determining racing candidates. Therefore, the Tulley reference would not be counterintuitive. Furthermore, the examiner interprets the automatic selection means of Stronach to require or imply some form of a random number generator means. For example, if there are 10 algorithms used to generate different sets of candidates than the system has to randomly designate which algorithm to use (1 to 10) each time the select button is actuated. Furthermore, each algorithm would have to randomly designate or select different candidates from a set of candidates (for instance 1 to 10) or designate the order based on the type of wager (Stronach discloses wagers such as "Pick A Winner", "Pick Two Any Order", "Pick Two Exact Order", etc (Pg. 9:5-10)). The above implies that some type of random number generator means would have to be used, but does not explicitly disclose a "random number generation" means. However, it is clear that Stronach provides a type of random automatic application means of selecting racing candidates. Examiner contends that random number generators are well known in the art and Tulley illustrates an

Art Unit: 3714

example of such that can be applied to horse racing. Examiner contends that both Stronach and Tulley are drawn towards the same field of endeavor (horse racing) and both references are drawn towards providing a player or user with an automatic means of generating quick picks or candidates for a race. At least for the above reasons, one skilled in the art would be motivated to combine Stronach and Tulley.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 3714

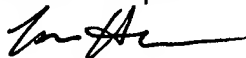
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Tramar Harper

Patent Examiner

Technology Center 3700




Conferees:

Xuan Thai

Supervisory Patent Examiner

Technology Center 3700



Eugene Kim Supervisory Patent Examiner

Technology Center 3700

